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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,361	12/31/2003	Nelson Minar	16113-001001 GP-064-07-US	4924
26192 7590 03/12/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3688	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/750,361	Applicant(s) MINAR, NELSON	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11-13,17-19,21-25,35-37,42 and 56-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11-13,17-19,21-25,35-37,42 and 56-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-71 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757.
3. The instant claims fail to meet this test. The claims fail to transform a particular article into a different state or thing. The claims are tied to a machine or apparatus, a "computer storage medium", but this is at best a nominal recitation that does not qualify as a *specific* machine and does not impose a meaningful limitation. Input and output, including the storing of data, is merely "insignificant extra-solution activity".
4. This rejection could be overcome by limiting the claims to "using a processor to select and return one or more targeted ads", which is supported by para. [0042] of the published application (US 20050165615A1).
5. Claims 72-76 are rejected under 35 U.S.C. § 101 because the claimed invention does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). In order to qualify as a "system", which the Office interprets to be a kind of "machine" (35 U.S.C. § 101) or "apparatus", the claims must be distinguishable over the prior art in terms of their *structure* (MPEP § 2114). It is not clear that the instant claims embody any structure. The examiner could not even find support for the claim to "a

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computer storage medium". At best, the claims appear to recite a computer program. Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.)

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 4-6, 11-13, 17-19, 21-25, 35-37, 42, and 56-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The following terms are not supported by the specification as filed and are accordingly indefinite:

in at least claim 1, "first information item", "information item of a channel" and "computer storage medium";

in at least claim 2, "the syndicated format is configured";

in at least claim 11, "generating the first targeted ad item in the syndicated format based on the first targeted ad";

in at least claim 22, "a geographic location to which the channel is forwarded";

in at least claim 23, "generating a second targeted ad item in the syndicated format based on the second targeted ad", "a second information item of the channel" and "forwarding the channel";

in at least claim 56, "the first information item in the channel";

in at least claim 65, "generating, based on the first targeted ad, a first targeted ad item in the syndicated format" and "generate a channel";

in at least claim 66, "receiving the first targeted ad comprises receiving a first targeted ad including the at least one keyword";

in at least claim 67, "the syndicated information/ad mixer being different from the user system and the search/content server".

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9. Claim 42 is indefinite because it contains an improper Markush group (MPEP § 2173.05(h)I). In claim 62, “syndicated content provider system” is indefinite. Although this language is used at many places in the published application (e.g., para. [0038]), it is not disclosed whether it is a business entity or a machine or apparatus. Businesses are distinguished by their ownership, are inherently indefinite and cannot impart patentability.

Claim Rejections - 35 USC § 102 and 35 USC § 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4-6, 11-13, 17-19, 23-25, 35-37, 42, and 56-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheth et al. (US006311194B1, hereafter “Sheth”).

13. Sheth teaches (independent claims 1, 65 and 72) a method and system of generating information including targeted ads (col. 16 lines 37-55), the method (as represented by claim 65) comprising:

receiving a user request, the user request including at least one keyword (*a domain of interest*, col. 13 lines 54-56);

receiving, in response to the at least one keyword, first information (*an XML string*, col. 16 lines 37-40 and col. 14 lines 23-25);

generating, based on the first information, a first information item (*individual media assets*, col. 16 lines 37-40), inherently in a format;

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receiving, in response to the at least one keyword, a first targeted ad (a semantically targeted advertisement, col. 16 lines 40-44);

generating, based on the first targeted ad, a first targeted ad item (*the advertisement* tailored to the content provider's own space, col. 15 lines 52-55), inherently in a format (tailored to the content provider's own space, col. 15 lines 52-55);

(inherently) storing, on a computer storage medium, the first information item and the first targeted ad item;

inserting the first targeted ad item adjacent to the first information item to generate a channel including the first information item and the first targeted ad item in a format (col. 15 lines 52-55); and

forwarding the channel including the first information item and the first targeted ad item (col. 15 lines 52-55).

The limitation "a syndicated format" is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A)). A "format" is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention. The arrangement of words or symbols on a page, including its format, constitutes printed matter and cannot patentably distinguish an invention over the prior art. "The ATOM Syndication Format is an XML language" (Google search of "syndicated format").¹

Similarly, no patentable weight was given to "the first information item including a first title, a first link, and a first description" because this is non-functional descriptive material. "Link" is given no clear definition in the specification. "Link" is associated by example with "URL", but that does not constitute the necessary clear definition for link (para. Xx20 herein). The examiner must give the term "link" its broadest reasonable definition, which the examiner judges to be any association, including a non-functional textual reference.

Similarly, no patentable weight was given to "the first targeted ad item including a targeted ad title, a targeted ad link, and a targeted ad description", or to "the channel including a channel title, a channel link, and a channel description", because this is non-functional descriptive material.

¹ Applicant's preferred term "syndicated format", was not be found by the Google search.

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14. Sheth also teaches at the citations given above claims 11-13, 17, 19, 23-25 (where “link” is given the broadest reasonable interpretation as any associating information), 42, 56, 62-64, 66 and 67 (where “ad mixer” is whatever mechanism is used to combine the delivered content and ad, col. 16 lines 52-55),
15. The following claims add only non-functional descriptive material and were not given patentable weight (MPEP § 2106.01): claims 2 (“channel” has no special clear definition in the spec. and is interpreted as any means for communication), 4-6, 18, 35-37, 57-60 (the arrangement of text is a non-functional artistic or formatting detail), 61, 68-71 and 73-76.
16. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being anticipated by Sheth et al. (US006311194B1, hereafter “Sheth”) in view of official notice. Sheth does not teach targeting ads by geography. Official notice is taken (MPEP § 2144.03) that this was a common means of targeting ads at the time of the instant invention. Since applicant failed to traverse the examiner’s assertion (para. 20 below), it is taken to be admitted prior art (MPEP 2144.03.C).

Response to Arguments

17. Applicant’s arguments filed with an amendment on 29 December 2008 have been fully considered but they are not persuasive. Concerning the rejection under 35 USC § 101 (para. 1-3 herein) for failure to comply with the “machine or transformation” test of *In re Bilski*, the examiner gave the applicant advice during the 17 December 2008 interview that is no longer sound. At present, the Office believes process claims cannot be statutory if tied only to a machine or apparatus doing input or output, as the instant process claims do. The examiner has provided claim language (para. 4 above) that will overcome the rejection, again based on the Office’s current understanding of the law. (On 29 January 2009 the *Bilski* inventors petitioned the U.S. Supreme Court to review the CAFC’s *Bilski* decision.)
18. Applicant argues (p. 17),

“The Office Action contends that a ‘syndicated format’ is non-functional descriptive material and does not give ‘syndicated format’ patentable weight. See Office Action mailed September 29, 2008 at page 3. As discussed in the interview, applicant respectfully submits that ‘syndicated format’ be given patentable weight because the first information item and the first targeted ad item in the syndicated format are functionally

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interrelated to the statutory method of amended independent claim 1. See, generally, In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 48-49 (CCPA 1969) ('The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.') (emphasis added); see also MPEP § 2106.01(II) ('Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101 .').” (Underlines added by examiner.)

First, there is very little “functional” in the instant claims. The present claims are not statutory (para. 1-5 herein). Second, both “the first information item” and “the first targeted ad item” are non-functional descriptive material. Third, even if said “first information item” and “first targeted ad item” were functionally related, it could not be because of the “syndicated format”. The best evidence suggests that a “syndicated format” is no more than a language (para. 13 herein), and applicant has submitted no evidence to the contrary.

19. Applicant argues (p. 18) that the spec. does clearly define “channel” by example. The examiner does not agree: Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.

20. Traverse of the taking of Official Notice - Applicant has traversed the examiner’s taking of official notice (pp. 18-19). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have performed a search for targeting ads by geography and gone on record with the implicit result that they found

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none in the prior art. The examiner would then have been compelled to produce a pertinent prior art references in order to maintain the taking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday, Wednesday morning, and after Noon on Thursday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
24. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
27. Applicant may have after final arguments considered and amendments entered by filing an RCE.
28. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
29. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

8 March 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688